

Intel Corporation
4030 Lafayette Center Drive
Chantilly, VA 20151

Page 1 of 7

Urgent and Confidential

Date: November 7, 2005

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TO: USPTO
Examiner James K. Trujillo
Art Unit 2116
Fax Number 571-273-8300

FROM: Paul E. Steiner
Fax Number 703-633-3303
Phone Number 703-633-6830

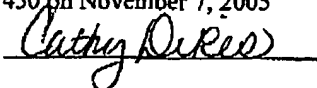
SUBJECT: Application Number 09/863,103
Inventor(s) John P. Lambino, et al.
Date Filed May 22, 2001
Docket Number P11071
Title Firmware Upgrade Using Address Conversion

INCLUDED IN THIS TRANSMISSION:

Fax Cover Sheet	1 page
Transmittal	1 page
Fee Transmittal	1 page
Notice of Appeal	1 page
Pre-Appeal Brief Request	2 pages
Extension of Time Request	1 page

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Cathy Dikes

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PTO/SB/21 (09-04)

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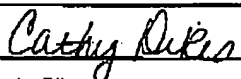
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TRANSMITTAL FORM (to be used for all correspondence after initial filing)	Application Number	09/863,103	
	Filing Date	May 22, 2001	
	First Named Inventor	John P. Lambino, et al.	
	Art Unit	2116	
	Examiner Name	James K. Trujillo	
Total Number of Pages in This Submission	7	Attorney Docket Number	P11071

ENCLOSURES (Check all that apply)		
<input checked="" type="checkbox"/> Fee Transmittal Form <input type="checkbox"/> Fee Attached <input type="checkbox"/> Amendment/Reply <input type="checkbox"/> After Final <input type="checkbox"/> Affidavits/declaration(s) <input checked="" type="checkbox"/> Extension of Time Request <input type="checkbox"/> Express Abandonment Request <input type="checkbox"/> Information Disclosure Statement <input type="checkbox"/> Certified Copy of Priority Document(s) <input type="checkbox"/> Reply to Missing Parts/ Incomplete Application <input type="checkbox"/> Reply to Missing Parts under 37 CFR 1.52 or 1.53	<input type="checkbox"/> Drawing(s) <input type="checkbox"/> Licensing-related Papers <input type="checkbox"/> Petition <input type="checkbox"/> Petition to Convert to a Provisional Application <input type="checkbox"/> Power of Attorney, Revocation Change of Correspondence Address <input type="checkbox"/> Terminal Disclaimer <input type="checkbox"/> Request for Refund <input type="checkbox"/> CD, Number of CD(s) _____ <input type="checkbox"/> Landscape Table on CD	<input type="checkbox"/> After Allowance Communication to TC <input type="checkbox"/> Appeal Communication to Board of Appeals and Interferences <input checked="" type="checkbox"/> Appeal Communication to TC (Appeal Notice, Brief, Reply Brief) <input type="checkbox"/> Proprietary Information <input type="checkbox"/> Status Letter <input checked="" type="checkbox"/> Other Enclosure(s) (please identify below): Fax cover sheet Pre-Appeal Request
Remarks _____		

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT		
Firm Name	Intel Americas	
Signature	/Paul E. Steiner/	
Printed name	Paul E. Steiner	
Date	November 7, 2005	Reg. No. 41,326

CERTIFICATE OF TRANSMISSION/MAILING		
I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below:		
Signature		
Typed or printed name	Cathy Dikes	Date November 7, 2005

This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 36 U.S.C. 122 and 37 CFR 1.11 and 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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PTO/SB/17 (12-04v2)

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U.S. Patent and Trademark Office, U.S. DEPARTMENT OF COMMERCE

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Effective on 12/08/2004.
Fees pursuant to the Consolidated Appropriations Act, 2005 (H.R. 4818).**FEE TRANSMITTAL**
For FY 2005☐ Applicant claims small entity status. See 37 CFR 1.27**TOTAL AMOUNT OF PAYMENT** (\$) 620.00**Complete If Known**

Application Number 09/883,103

Filing Date May 22, 2001

First Named Inventor John H. LIEDER

Examiner Name James K. Trujillo

Art Unit 2116

Attorney Docket No. P11071

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METHOD OF PAYMENT (check all that apply)

- ☐ Check ☐ Credit Card ☐ Money Order ☐ Nonc ☐ Other (please identify): _____
- ☒ Deposit Account Deposit Account Number: 50-0221 Deposit Account Name: Intel Corporation
- For the above-identified deposit account, the Director is hereby authorized to: (check all that apply)
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- ☒ Charge any additional fee(s) or underpayments of fee(s) under 37 CFR 1.16 and 1.17 ☒ Credit any overpayments

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FEE CALCULATION**1. BASIC FILING, SEARCH, AND EXAMINATION FEES**

Application Type	FILING FEES		SEARCH FEES		EXAMINATION FEES		Fees Paid (\$)
	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES**Fee Description**

Each claim over 20 (including Reissues)

Fee (\$)

Small Entity Fee (\$)

Each independent claim over 3 (including Reissues)

50

25

Multiple dependent claims

200

100

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

360

180

- 20 or HP = 0 x 50.00 = 0

Multiple Dependent Claims

HP = highest number of total claims paid for, if greater than 20.

Fee (\$)

Fee Paid (\$)

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

- 3 or HP = 0 x 200.00 = 0

HP = highest number of independent claims paid for, if greater than 3.

3. APPLICATION SIZE FEE

If the specification and drawings exceed 100 sheets of paper (excluding electronically filed sequence or computer listings under 37 CFR 1.52(e)), the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

Total Sheets **Extra Sheets** **Number of each additional 50 or fraction thereof** **Fee (\$)** **Fee Paid (\$)**

- 100 = / 50 = (round up to a whole number) x =

4. OTHER FEE(S)

Non-English Specification, \$130 fee (no small entity discount)

Fees Paid (\$)

Other (e.g., late filing surcharge): Extension of Time (\$120) Notice of Appeal (\$500)

620.00

SUBMITTED BY

Signature	/Paul E. Steiner/	Registration No. (Attorney/Agent)	41,326	Telephone	703-633-6830
Name (Print/Type)	Paul E. Steiner	Date	November 7, 2005		

This collection of information is required by 37 CFR 1.136. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 30 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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In re patent application of:

John P. LAMBINO, et al.

Serial No.: 09/863,103

Group Art Unit: 2116

Filed: May 22, 2001

Examiner: J. Trujillo

FOR: FIRMWARE UPGRADE USING ADDRESS CONVERSION

PRE-APPEAL BRIEF REQUEST FOR REVIEW

Mail Stop After Final
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the procedures outlined in the Official Gazette published July 12, 2005, applicants respectfully request review of the following clear errors in the final office mailed July 6, 2005, in connection with the above-identified application.

With respect to independent claims 1, 6, 12, 17, 20, and 24, see applicants' arguments on pages 1-4 of applicants' response filed September 6, 2005. In particular, the Examiner admits that Miller teaches only setting a flag. The setting of a flag is different from and does not teach or suggest modifying an address bit of the execution address. The Examiner admits that Miller teaches only maintaining the state of the flag. The state of the flag does not correspond to the state of the address line A16. Miller does not teach or suggest that the state of the address line A16 is maintained during a power cycle.

With respect to claims 10-11 and 22-23, see applicants' arguments on pages 4-5 of applicants' response filed September 6, 2005. In particular, the Examiner does not meet the burden of proof required to establish inherency. Contrary to the Examiner's

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09/863,103

understanding set forth in the Advisory Action mailed September 21, 2005, the burden of proof for relying on inherency is the same for both § 102 and § 103 rejections.

In view of the foregoing, favorable reconsideration and withdrawal of the rejections is respectfully requested. Early notification of the same is earnestly solicited. If there are any questions regarding the present application, the Review Panel is invited to contact the undersigned attorney at the telephone number listed below.

Respectfully submitted,

November 7, 2005

Date

/Paul E. Steiner/

Paul E. Steiner

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(703) 633 - 6830

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Chantilly, VA 20151

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